



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/675,467 | 09/28/2000 | Arnold N. Blinn | MSI-624US | 8910 |

22801 7590 05/19/2005

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

| |
|----------|
| EXAMINER |
|----------|

PATEL, JAGDISH

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3624

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,467

Applicant(s)

BLINN ET AL.

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-33 and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26,28-33 and 43-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to amendment filed 3/1/05.

Response to Amendment

2. Claim 26 has been amended, claims 1-25 and 34-42 have been canceled and new claims 43-54 have been added. Currently claims 26-33 and 43-54 are pending and have been subject of the examination.

3. In response to the amendment and accompanying arguments, objections to claims and rejections under 35 USC 112(second) have been withdrawn.

Response to Arguments

4. Applicant's arguments with respect to claims 26 and 28-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 54 is rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a "new and useful process, machine,

Art Unit: 3624

manufacture or composition of matter or new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above is intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a system (ex. Preamble of claim 52 and 54), the body of the claim discusses the specifics of a method step (maintaining..restrictions). "a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte Lyell (17USPQ2d 1548).

7. Claims 52-53 are rejected as non functional data structure or

computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

This deficiency is also present in each of the dependent claims 53 and 54.

To correct this deficiency the system must claim a processor means connected to the means for maintaining a payment account and the means for restricting such that the processor causes the functionality of the restricting means to be realized.

Claim Rejections - 35 USC § 112

8. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

Art Unit: 3624

distinctly claim the subject matter which applicant regards as the invention.

See explanation under 35 USC 101. Claim 54 is rendered indefinite due to recitation of limitations of multiple statutory classes.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 26, 28, 30-33, 43-45 and 47-54 are rejected under 35 U.S.C. 102(e) as being Oneda (US Pat. 6,611,819) (hereafter referred to as by Oneda).

As per claim 26, Oneda teaches a computerized method comprising:

maintaining a payment account in a user-accessible electronic wallet corresponding to a particular user; and

Art Unit: 3624

restricting wherein the funds in the payment account can be spend.

(see at least col. 1 L 58-63 "The IC card has a built-in integrated circuit including a processor and a memory, the memory storing therein a general electronic money balance having an unlimited use range, a specific electronic money balance having a limited use range, and available genre information defining a use range of the specific electronic money balance."

Col. 2 L 3-8 "When a coincidence occurs, the settlement processing unit deducts the purchased amount of money from the specific electronic money balance of the card, whereas when a non-coincidence occurs, it prohibits the deduction from the specific electronic money balance." And

Col. 10 L 27-52 refer to "available store codes" and other specific categories to which the spending of the balance in the IC-card may be restricted.)

Claim 28 and 30 restricting which on-line merchants the funds can be spend at.. and the on-line merchants are a group of merchants that changes over time (see Fig 6A "available store codes" which may be modified and specifies as a group of merchants because Oneda allows specifying "use object" which include type of expenses such as transportation expenses, school expenses which inherently include a respective group of merchants where the IC-card (account) balance can be spent).

Claim 31: restricting how the funds in the payment account can be combined with funds from another payment account prior to being spent.

(Col. 9 L 65- col. 10 L 4 "The specific genre 60 is combined with transferred specific electronic money balance 50 and transferor management information 62. Transferred electronic money information 58-1 is created for each specific electronic money transfer and is made up of the specific genre 60, the specific electronic money balance

Art Unit: 3624

50 and the transferor management information 62. This example includes three transferred electronic money information 58-1, 58-2 and 58-3.)

Claim 32: payment account comprises one of : a credit card account, a cash account, an allowance account or a reward account.

(refer to col. 2 L 7-19, the child's account (wherein the parent has transferred electronic money) is equivalent to a cash account or a reward account etc.)

claim 33: restricting different payment accounts in the electronic wallet in different manners.

(col. 2 L 23-44 refer to "genre information" or "use limit information" stored in the IC-card. By use "use limit flags" Oneda restricts different "use objects")

claim 43: maintaining ..restrictions regarding where the funds in the payment account can be spent

(refer to detailed description of "use limit information" or "specific genre information" discussed above. Also see discussion of item 48-2 of Figure 4)

Apparatus claims 44, 45 and 47-51 are analyzed according to respective method claims 26, 28, 30-33 and 43.

System claims 52-54 are analyzed according to respective method claims 26, 31 and 43.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 3624

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claim 32 and 46 rejected under 35 U.S.C. 103(a) as being unpatentable over Oneda as applied to claim 26 and further in view of Official Notice.

Regarding claim 32: Oneda fails to explicitly teach, however Official Notice is taken that providing expiration date for credit cards, gift cards and smart card is old and well known in the commercial art.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to limit the use of the payment account via an expiration date because this would enhance security of the funds maintained in the electronic wallet.

Apparatus claim 46 corresponds to method claim 32 and has been similarly analyzed.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS**

Art Unit: 3624

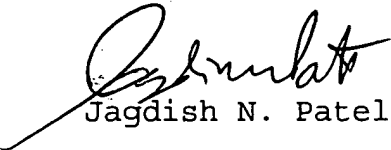
of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/13/05